

Appl. No. 10/807,213  
Amdt. Dated Jan. 16, 2007  
Reply to Office Action of October 16, 2006

## **REMARKS**

At first, the applicants acknowledge the examiner's action mailed on 10/16/2006.

### **1. Election/Restrictions**

The Examiner states that newly submitted claims 16-20 are directed to an invention that is independent or distinct from the invention originally claimed.

The applicants have withdrawn claims 19-20 with traverse. Meantime, the applicants have canceled claims 1-7 and 16-18 without prejudice and added new claims 21-33.

The reasons for traverse are given below.

The Examiner regards claims 1-7 and 16-20 are related as mutually exclusive species in an intermediate and final product relationship, based upon MPEP §806.05(j).

*MPEP §806.05(j) states: an intermediate product and a final product can be shown to be distinct inventions if the intermediate and final products are mutually exclusive inventions (not overlapping in scope) that are not obvious variants, and the intermediate product as claimed is useful to make other than the final product as claimed. Typically, the intermediate loses its identity in the final product.*

Anyhow, it is not the case in the instant application. Both groups claims 1-7 and claims 16-20 refer to FIGS. 2-3, and the only difference therebetween is that claims 16-20 focuses upon the pair of terminals while claims 1-7 further include the carrier strip.

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It is clear that claims 1-7, i.e., the intermediate product, and claims 16-20, i.e., the final product, both focuses upon the same structural features of the pair of switch terminals. It can not meet the restriction requirement defined in *MPEP §806.05(j)* that the intermediate and final products are mutually exclusive inventions (not overlapping in scope) that are not obvious variants. In fact, it is obvious to the skilled that removal of the carrier strip is the necessary action for the switch terminal assembly. Please see the cite reference (U.S.Pat.5,860,821, column 3, lines 22-23), a removal of the carrier strip is obvious for achieving a final product.

Essentially, claims 1-7 and 16-20 should belong to the combination and subcombination relationship under an overlapping manner with each other which is prohibited by *MPEP §806.05(j)*. *MPEP §806.05(c)* states: the inventions are distinct if it can be shown that a combination as claimed:

(A) does not require that particulars of the subcombination as claimed for patentability (to show novelty and unobviousness).

Clearly, without the features of the subcombination defined in claims 16-20, claims 1-7 having limitations of the carrier can no longer own novelty and obviousness.

The Examiner states that the intermediate product is deemed to be useful as a bridge short-circuit element. Anyhow, the subject matter of the pair of terminals as claimed in both claims 1-7 and 16-20 is a switch terminal assembly which is not expected or fit to be used for or as the short-circuit element. On the other hand, generally speaking the grounding contacts of a meaningful grounding bar (i.e., the short-circuit element) are essentially of the similar/same configuration with possibilities to contact with the external part, not with each other.

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Because MPEP §806.05(i) requires (I) the intermediate and final products are mutually exclusive inventions (not overlapping in scope) that are not obvious variants, and (II) the intermediate product as claimed in useful to make other than the final product as claimed. Disregarding whether the claims 1-7 and 16-20 satisfy criteria (II), it is clear that such claims can NOT meet criteria (I). Therefore, because MPEP §806.05(i) requires both criteria (I) and (II) and the claims can NOT meet at least criteria (I), restriction requirement should be removed.

It is further proved that claims 1-7 and 16-20 are essentially of the combination and subcombination relationship under an overlapping/obvious manner, and thus restriction requirement should be removed.

It seems that the Examiner implies claims 16-20 should be withdrawn due to claims 9-15 being non-elected in an earlier time. Applicant respectfully traverses it.

The initial election was made, on Oct. 26, 2005, between the apparatus claims and the method claims, not the combination claims and the subcombination claims. The applicant chose the apparatus/article claims at that time while the applicant never waived the right to keep the combination and subcombination claims together. The reason why the applicant withdrew/canceled claims 9-15 is due to the instant application being at the after final stage at that time.

Accordingly, in RCE the Examiner has been respectfully requested claims 19-20 be reconsidered.

The applicants have added new claims 21-27, wherein the Claim 21 defines: (1) a first contact section formed extending perpendicularly from

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the first base section; (2) said second terminal have a cutout defined in an inner edge thereof facing the first terminal; and (3) portions of said second terminal around said cutout experiences deformation due to rotation of said second terminal about said cutout.

Referring to item (1), if the examiner considers that Pernet (U.S. Pat. 5,860,821) anticipates item (1), the element in Pernet, which regarded by examiner as the first terminal, is pointed only at blade member 4 shown in FIG. 1, for only the blade member 4 disclosing a traverse part labeled after 22. However, for above supposal, Pernet cannot anticipate item (2), for the other blade member 5 being extending along a lengthwise direction thereof without any deflection, and a cutout being defined in an outer edge in Pernet.

In addition, referring to the instant invention, the cutout is defined in an inner edge of the second terminal, and portions of said second terminal around said cutout experiences deformation due to rotation of said second terminal about said cutout. Contrastively, for above explanation, only the blade member 5 can be regarded as the second terminal of the instant invention by examiner. However, the cutout shown in FIG. 1 of Pernet, is defined in outer edge thereof, and the blade member 5 never experienced deformation by rotation about said cutout for achieving an overlapped relation.

In brief, based on above remarks, the allowance of new Claim 21 is respectfully requested.

Accordingly, Claims 22-27 are allowable for their dependency from new independent Claim 21, either directly or indirectly.

Claims 28 is essentially the previous claim 16 except further including

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carrier strip, and defines a tip section of the pressing portion being essentially located at a same level with the first contact section, and said pressing portion is offset from said main plane from a side view. Pernet can not meet this limitation. Thus, claim 28 is patentable over Pernet. Claims 29-33 depending from claim 28 are also allowable by reason of at least their dependencies upon claim 28.

Similar to claim 21 but except lacking the limitation of the carrier strip, claim 19 defines (I) said first contact section essentially extends in a transverse direction with regard to a longitudinal direction of the first terminal, (II) a cutout is formed in an inner edge of said second terminal, facing the first terminal, (III) portions of said second terminal around said cutout experiences deformation due to rotation of said second terminal about said cutout. Pernet can not meet these limitations. Claim 19 and the associated claim 20 are believed to be patentable over the cited reference.

In view of the above claim amendments and remarks, the subject application is believed to be in a condition for allowance and an action to such effect is earnestly solicited.

Respectfully submitted,  
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